

Notice of Allowability

Application No.

09/724,744

Examiner

James H. Zurita

Applicant(s)

PIENKOS, JOHN THADDEUS

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/30/06.
2. ☒ The allowed claim(s) is/are 59-78.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

Notice of Allowability

On 30 December 2006, Applicant cancelled pending claims 35, 36, 38, 39, 41 and 44-58 and added claims 59-78.

Claims 59-78 are allowed. Claims 59, 76 and 78 are independent.

Examiner's Amendment

Permission for this amendment was given by Mr. Pienkos on 12 January 2006.

Please amend the claims as follows:

59. ~~(New)~~(currently amended) A method of facilitating an overall transfer of at least one property interest in a patent asset between first and second parties by way of the web, the method comprising:
- (a) providing an interface by way of a computer system of an intermediary by which at least one of the first and second parties can communicate with the intermediary;
 - (b) receiving identification information from at least one of the first and second parties;
 - (c) obtaining first information concerning the patent asset, wherein the first information includes at least one of a number identifying the patent asset, a filing date, an issue date, expiration information, descriptive information concerning a technical subject matter of the patent asset, product information regarding a product that is within a scope of the patent asset, and market information regarding a market to which the patent asset pertains;

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- (d) verifying at least one aspect of property rights of the first party in the patent asset;
- (e) performing at least one evaluation, wherein the evaluation relates to at least one of a financial value of the patent asset, a technological scope of the patent asset, a product coverage of the patent asset, a market for products covered by the patent asset, and whether there have been ~~one or more~~ at least one of past inquiries concerning the patent asset;
- (f) negotiating conditions for transfer of at least some of the first party's property rights;
- (g) transferring the at least some of the first party's property rights to the intermediary based on an agreement resulting from the negotiating of (f), whereby the at least some of the first party's property rights become property rights of the intermediary;
- (h) negotiating conditions for transfer of at least some of the intermediary's property rights in the patent asset; and
- (i) ~~transfering~~ transferring the at least some of the intermediary's property rights in the patent asset to the second party based on an agreement resulting from the negotiating of (h).

62. ~~(New)~~ (currently amended) The method of claim 59, wherein the conditions for transfer in (f) include ~~one or more~~ at least one of of a price, a royalty rate, another payment indication, and a condition identifying which of the first party's property fights are to be transferred, and

wherein the conditions for transfer in (h) include ~~one or more~~at least one of of a price, a royalty rate, another payment indication, and a condition identifying which of the intermediary's property rights are to be transferred.

63. (New)(currently amended) The method of claim 62, wherein the at least some of the first party's property rights that are transferred include at least one of a full assignment and a first license, *and*

wherein the at least some of the intermediary's property rights that are transferred include at least one of a full assignment, the first license and a second license, *and*

wherein each ~~assignment or license~~assignment and license includes a respective set of associated property rights.

65. (New)(currently amended) The method of claim 59, further comprising at least one of:

prior to (f), obtaining additional information regarding an extent of the first party's patent rights that the first party is interested in transferring to the intermediary; ~~or~~and, prior to (h), obtaining further information regarding an extent of the intermediary's patent rights that the second party is interested in having transferred from the intermediary.

66. (New)(currently amended) The method of claim 59, wherein the interface includes at least one field for receiving input information,

wherein at least a portion of ~~one or more~~at least one of of the identification information, the first information, the conditions for transfer in (f), the conditions for

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transfer in (h), the agreement of (g), ~~or the agreement~~ and the agreement of (i) is received by way of the at least one field of the interface via an internet-type network.

67. (New)(currently amended) The method of claim 66, wherein the computer system of the intermediary includes a server ~~capable of hosting a website, and~~
wherein the website hosted by the server is ~~capable of providing~~ provides a plurality of web pages that form at least a portion of the interface.

68. (New)(currently amended) The method of claim 59, wherein at least a portion of ~~one or more~~ at least one of the identification information, the first information, the conditions for transfer in (f), the conditions for transfer in (h), the agreement of (g), ~~or the agreement~~ and the agreement of (i) is obtained by the intermediary by at least one of prompting a user to answer a question, providing a selectable item, and providing an open entry space into which the user can provide a submission, ~~OR~~ And

wherein the intermediary receives username and password information from the first and second parties by way of the interface.

70. (New)(currently amended) The method of claim 59, wherein at least one of following is performed ~~automatically~~ by way of the computer system of the intermediary: the verifying of the at least one aspect of the property fights; the evaluation; preparing of the agreement resulting from the negotiating of (f); and preparing of the agreement resulting from the negotiating of (h).

73. (New)(currently amended) The method of claim 59, wherein the intermediary interacts with an exchange entity to at least one of browse and ~~or~~ retrieve information

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from the exchange entity ~~and/or~~ to place ~~and/or~~ respond to a bid communicated via the exchange entity.

74. (New)(currently amended) The method of claim 73, wherein the computer system of the intermediary is in communication with an additional computer system of the exchange entity, *and*

wherein the computer system of the intermediary employs software facilitating interactions with the additional computer system of the exchange entity.

75. (New)(currently amended) The method of claim 59, further comprising at least one of

(i) comparing at least one of the technological scope of the patent asset, the product coverage of the patent asset, and the market for products covered by the patent asset with additional information received from a plurality of parties concerning needs of those parties relating to patent rights;

(ii) comparing a first description of a need of at least one additional party relating to patent rights with further information received from a plurality of further parties concerning patent assets available for transfer from those parties; and

(iii) consulting at least one of a public ~~and/or~~ private database to identify an owner of a desired patent asset and, upon identifying the owner, contacting the owner.

76. (New)(currently amended) A method of facilitating an overall transfer of at least one property interest in a patent asset between first and second parties by way of the web, the first and second parties each being a respective corporate entity, the method comprising:

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- (a) providing an interface by way of a computer system of an intermediary by which at least one of the first and second parties can communicate with the intermediary;
- b) receiving identification information from at least one of the first and second parties by way of at least one of the web, the internet, a mail delivery, a telephone connection and another communication linkage;
- (c) obtaining first information concerning the patent asset, wherein the first information includes at least one of a number identifying the patent asset, a filing date, an issue date, expiration information, descriptive information concerning a technical subject matter of the patent asset, product information regarding a product that is within a scope of the patent asset, and market information regarding a market to which the patent asset pertains;
- (d) verifying at least one aspect of property rights of the first party in the patent asset, wherein the verifying includes checking an ownership status of the patent asset;
- (e) performing at least one evaluation, wherein the evaluation relates to at least one of a financial value of the patent asset, a technological scope of the patent asset, a product coverage of the patent asset, a market for products covered by the patent asset, and whether there have been ~~one or more~~ at least one of past inquiries concerning the patent asset, the evaluation being performed at least in part by an employee of the intermediary;
- (f) negotiating conditions for transfer of at least some of the first party's property rights;

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(g) transferring the at least some of the first party's property rights to the intermediary based on an agreement resulting from the negotiating of (f), whereby the at least some of the first party's property rights become property rights of the intermediary;

(h) negotiating conditions for transfer of at least some of the intermediary's property rights; and

(i) ~~transfering~~transferring the at least some of the intermediary's property rights to the second party based on an agreement resulting from the negotiating of (h).

77. (currently amended) The method of claim ~~77~~76, wherein the intermediary is an investment bank for which facilitating intellectual property transfers is a primary business purpose, wherein at least some of (a)-(i) in addition to (e) are performed by at least one human being, and wherein the conditions for transfer in (f) include a requirement to transfer at least one of ~~that either an assignment of the patent asset~~ and a license to the patent asset ~~be transferred~~.

78. ~~(New)~~(currently amended) A method of facilitating an overall transfer of at least one property interest in a patent asset between first and second parties by way of the web, the first and second parties each being a respective corporate entity, the method comprising:

(a) providing an interface by way of a computer system of an intermediary by which at least one of the first and second parties can communicate with the intermediary;

b) receiving identification information from at least one of the first and second parties;

- (c) obtaining first information concerning the patent asset, wherein the first information includes at least one of a number identifying the patent asset, a filing date, an issue date, expiration information, descriptive information concerning a technical subject matter of the patent asset, product information regarding a product that is within a scope of the patent asset, and market information regarding a market to which the patent asset pertains;
- (d) verifying at least one aspect of property rights of the first party in the patent asset;
- (e) performing at least one evaluation, wherein the evaluation relates to at least one of a financial value of the patent asset, a technological scope of the patent asset, a product coverage of the patent asset, a market for products covered by the patent asset, and whether there have been ~~one or more~~ at least one of past inquiries concerning the patent asset;
- (f) negotiating conditions for transfer of at least some of the first party's property rights;
- (g) transferring the at least some of the first party's property rights to the intermediary based on an agreement resulting from the negotiating of (f), whereby the at least some of the first party's property rights become property rights of the intermediary;
- (h) negotiating conditions for transfer of at least some of the intermediary's property rights; and
- (i) ~~transfering~~ transferring the at least some of the intermediary's property rights to the second party based on an agreement resulting from the negotiating of (h),

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wherein the transferring in at least one of ~~one or both of~~ (g) and (i) occurs by way of an additional exchange entity with which the intermediary interacts, *and*

wherein at least one of (a)-(i) is performed at least in part by way of an employee of the intermediary.

Reasons for Allowance

Applicant's amendment and remarks of 13 November 2006 are persuasive.

Updated searches were carried out on 11 January 2007.

The prior art of record is not found to teach or suggest the combination of steps, at a web site, of independent claims s59, 76 and 78, including:

- (a) providing an interface by way of a computer system of an intermediary by which at least one of the first and second parties can communicate with the intermediary;
- (b) receiving identification information from at least one of the first and second parties;
- (c) obtaining first information concerning the patent asset...
- (d) verifying at least one aspect of property rights of the first party in the patent asset;
- (e) performing at least one evaluation...
- (f) negotiating conditions for transfer of at least some of the first party's property rights;
- (g) transferring the at least some of the first party's property rights to the intermediary...
- (h) negotiating conditions for transfer of at least some of the intermediary's property rights; and
- (i) transfer ring the at least some of the intermediary's property rights to the second party ...

The closest US reference is previously cited Kossovsky, PG-PUB 2002/0004775A1, published 10 January 2002, filed 20 April 2001 and claiming priority to 17 March 1999. Kossovsky discloses an exchange that auctions rights to patents without obtaining property rights in those patents by the exchange. However, the

reference fails to disclose the outright transfer of rights from a first party to an intermediary to a second party found in steps (f) through (i) of the instant application.

The closest foreign reference is JP02000268111A, by Kossovsky et al, published in Japan on 29 September 2000 claiming priority to 17 March 1999, which discloses a bidding system among buyers of patents listed on an exchange. Again, Kossovsky does not teach, *inter alia*, outright transfer of rights from a first party to an intermediary to a second party found in steps (f) through (i) of the instant application.

The closest non-patent literature reference is Carlson, *Patent pools and the antitrust dilemma*, Yale Journal on Regulation. New Haven: Summer 1999. Vol.16, Iss. 2; pg. 359, 47 pgs, which discloses:

Patent pools are private contractual agreements whereby rival patentees transfer their rights into a common holding company for the purpose of jointly licensing their patent portfolios. Pools can comprise as few as two patents, or as many as hundreds. Although the contractual provisions governing each pool are tailored to the technologies and patents at hand, patent pools generally share two common characteristics. First, patent pools consolidate the patent rights into a central, independent entity. In many cases, the entity will be a partnership or limited liability corporation.

Carlson does not disclose or reasonably suggest Applicant's claimed features, *inter alia*, specific web-based and other electronic communications functionality recited. In addition, the Examiner notes that the business model described teaches away from the patent pool concept described by Carlson, including characteristics whereby pool companies consolidate patent rights into a central, independent entity that, in many cases, are partnerships or limited liability corporations controlled by the founders.

The Examiner notes that on 31 October 2003, applicant submitted prior art relating to MPED LA. In the Justice Department letter of 26 June 1997, DOJ approved a proposal by a group of nine companies and one university that wanted to create a

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one-stop-shopping clearinghouse by pooling their patents. Under the group's proposal, a jointly owned agent known as MPEG LA would license these patents in a single package that would enable manufacturers to meet an international standard known as MPEG-2 video compression technology. Again, the business model described teaches away from the patent pool concept described by the DOJ letter, including a jointly owned agent that licenses the patents in a single package to the entities that create the clearinghouse.

In contrast to Carlson and the DOJ letter, Applicant's invention relates to an intellectual property investment bank that has numerous interactions with many different parties at arms' length--that is, the first and second parties need not have any previous relationship with the intermediary in the sense of being founders of the entity or otherwise. This is supported by the Specification of the present Application at, for example, page 38, line 16.

Conclusion

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statements for Reasons for Allowance."

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H. Zurita whose telephone number is 571-272-6766. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James Zurita
Primary Examiner
Art Unit 3625
12 January 2007

James Zurita
Primary Examiner